

REMARKS/ARGUMENTS

In the Examiner's Answer dated November 21, 2006, new grounds of rejection were applied such that the Applicant had the option to reopen prosecution under 37 C.F.R. § 41.50(a)(2)(i). By this amendment, the Applicant hereby reopens prosecution in the above identified U.S. patent application.

Claims 1-48 currently stand rejected. More specifically, claims 1-11, 14-24, 28-30 and 43-48 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,024,996 to Ringe in view of U.S. Patent No. 6,242,033 to Sander. Additionally, claims 12, 13, 25-27 and 31-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ringe in view of Sander and further in view of U.S. Patent No. 6,149,965 to van Lengerich et al. With this amendment, claims 1, 12, 13, 25, 27, 30, 31 and 32 have been amended. In view of the following remarks and amendments to the claims, the Applicant respectfully requests reconsideration of the application.

In essence, the Examiner argues that the claims presented in the present application simply combine known ingredients in the art without producing any unexpected results. Thus, having found references which teach the individual ingredients presented in the claims, the Examiner holds that it would have been obvious to one of ordinary skill in the art to make the cereal product containing both high fiber and high protein as specifically claimed. These rejections are respectfully traversed for at least the reasons set forth below.

The present invention is particularly directed to a cereal dough product having both a high fiber and a high protein content, where the fiber includes both insoluble and soluble fiber. More particularly, the present invention is directed to a combined high fiber and high protein content which overcomes the problems associated with the combination of high protein and high fiber into a cereal. When evaluating the present invention, it is important to note that the combination of particular ingredients as claimed

is not merely a recipe, but is a formula for a product which results from the chemical reaction of ingredients during a cooking process. The amount of starch component in a cereal is extremely important to the chemical and, hence, physical properties of a product. As the fiber content of a cereal increases, the starch components must decrease, adversely affecting the cereals organoleptic and physical properties. Further, cereals high in insoluble fiber are often dry, exhibit short bowl lives and yield highly frangible food pieces. Conversely, cereals high in soluble fiber are typically gummy or slimy upon consumption. The Applicant also notes that the addition of protein to RTE cereals creates additional challenges because the amount of starchy constituent in the cereal is necessarily decreased in direct proportion to the increase in fiber and protein.

In a preferred embodiment of the invention, the Applicant discovered that the problems associated with the prior art can be overcome by utilizing certain concentrations of inulin as a soluble fiber source. Inulin has the ability to act as a sweetener and may be utilized in a product before or after cooking. In order to more distinctly claim the invention, claims 1 and 30 have been amended such that the soluble fiber source includes inulin. Support for this limitation can be found, for example, on page 4, paragraph 19. In contrast, Ringe is directed to a RTE cereal having only high levels of soluble fiber, while Sander is directed to a cereal having only high levels of protein. Neither the Ringe nor the Sander references teach or suggest the use of inulin. For at least this reason, each of the limitations of claims 1-11, 14-24, 28-30 and 43-50 is not been met by the combination of Ringe in view of Sander and, therefore, the rejection of claims 1-11, 14-24, 28-30 and 43-48 should be withdrawn.

In addition to the above rejections, claims 12, 13, 25-27 and 31-42 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Ringe in view of Sander and further in view of U.S. Patent No. 6,149,965 to van Lengerich et al. Changes have been made to claims 12, 13, 25, 26, 27, 31 and 32 in order to more distinctly claim the subject invention. More specifically, claims 12, 13, 25 and 32 have been amended to be consistent with changes made to claims 1 and 30. Additionally, claims 26, 27 and 31

have been amended to further require a supplemental soluble fiber. See page 8, paragraph 36. It is respectfully submitted that none of the prior art discloses or suggests the combination of the multiple forms of fiber and plant protein ingredients presented in the specific ranges claimed.

As noted by the Examiner, Ringe does not disclose adding inulin, adding inulin in a sugar coating, the amount of inulin in a coating or adding inulin after cooking. See page 5 of the Examiner's Answer. Additionally, Ringe does not teach adding high levels of protein in combination with high levels of soluble fiber. Instead, the Examiner relies on Sander, which teaches a cereal having high levels of protein and some fiber. The Examiner asserts that one of ordinary skill in the art would have been motivated to combine Sander with Ringe to make the food product of Ringe more nutritious. However, this argument overlooks that fact that the problems associated with the combination of high fiber and high protein are the very problems addressed by the current invention. High fiber and high protein have not been combined in the past because of the physical and chemical problems associated with their combination in a cooked cereal product. The Examiner asserts that the presence of small amounts of fiber in a high protein cereal indicates that fiber and protein are totally compatible in a cereal product. This is simply not the case. As previously noted, cereals high in insoluble fiber are often dry, exhibit short bowl lives and yield highly frangible food pieces. Conversely, cereals high in soluble fiber are typically gummy or slimy upon consumption. Further, the addition of protein to RTE cereals creates additional challenges because the amount of starchy constituent in the cereal is necessarily decreased in direct proportion to the increase in fiber and protein.

The Applicant would again like to emphasize that the test for patentability under 35 U.S.C. § 103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of

ordinary skill in the art must be considered, along with the relevant secondary issues.
Graham v. John Deere Co., 381 U.S. 1, 148 USPQ 459 (1966).

The Applicant asserts that the list of ingredients approved by the FDA for human consumption cannot, by itself, provide the motivation needed to combine references. In the present situation, a cereal product with both insoluble and soluble fiber ingredients is known. In addition, a cereal with a protein ingredient is known. All of these ingredients are on the list of FDA approved ingredients. However, this just indicates that pieces of the present invention were known, which is irrelevant. See *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 218 USPQ 865, 870 (1983). None of the prior art discloses or suggests the combination of the multiple forms of fiber and the plant protein ingredient claimed. Again, the Ringe patent has been around for over a decade and the Sander patent has been around for years as well, still there does not exist any reference to the claimed combination of ingredients, nor any suggestion or motivation to combine. The Examiner appears to hold that the combination is obvious simply because all the pieces of the invention are known. As set forth above, the courts have already ruled against taking such a position. Moreover, if a manufacturer wishes to produce a product that will meet with FDA approval, all the ingredients must be on the list of FDA approved ingredients. That is, all existing food items are combinations of known ingredients. It is the combination, processing and final product that form the invention. Thus, without a motivational teaching in the art to combine the known ingredients in the manner specifically claimed, the Applicant respectfully submits that the Examiner has not satisfied her burden of establishing a prima facie case of obviousness.

In the present situation, the invention addresses the problems with dry, short lived, highly frangible features of high insoluble fiber products, gummy or slimy consumption features of high soluble fiber products, and decreased starchy constituents in connection with at least high protein products in arriving at a high insoluble fiber, high soluble fiber and high protein ingredient cooked dough product that has superior organoleptic attributes or qualities as discussed in the specification. The Applicant

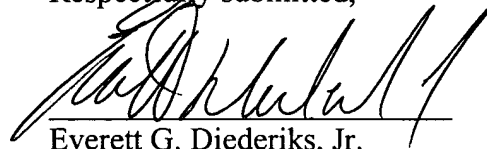
maintains that it is improper to combine the prior art, which does not equally address these problems or arrive at the inventive solution, by simply piecing together ingredients from various references. As a whole, Ringe is not concerned with a high protein product. As a whole, Sander is not concerned with a high multi-fiber product. Simply stated, neither Ringe nor Sander suggest making a combination high multi-fiber and high protein cooked dough product and it is not permissible for the suggestion of the combination to simply come from the Examiner for a proper prima facie case of obviousness. That is, it is clear that it is the PTO that has to establish a prima facie case of obviousness and "obvious can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and *Ray Geiger*, 815 F.2d 686 (Fed. Cir. 1987).

In a similar manner, van Lengerich et al. is not concerned with a high insoluble fiber, high soluble fiber and high plant protein product such that the mere fact that van Lengerich et al. teaches to make a cereal dough with inulin does not detract from the inventiveness of the combination set forth in this application.

The Examiner attempts to shift the burden of proof to the Applicant to show unexpected results. However, the burden of proof only shifts to an Applicant when a prima facie case of obviousness has been established. In the present case, it is respectfully submitted that the Examiner has failed to establish such a prima facie case. In general, there is no requirement that a claimed invention attain an "unexpected result" before a conclusion of non-obviousness may be reached. See *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), remanded, 475 U.S. 809, 229 USPQ 478 (1986), on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987).

Based on the above, it is respectfully requested that the prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Everett G. Diederiks, Jr.', written over a horizontal line.

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